

REMARKS

This paper is filed in response to the Office Action. Claims 4-7 and 9 are allowed, and claims 1-3, 8 and 10-26 are rejected. Applicant herein amends independent claim 1.

Rejections under 35 U.S.C. § 112 ¶ 1

At pages 2-3 of the Office Action, Examiner states that claims 10-26 are rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement. Specifically, Examiner states that independent claims 10, 11, 15, 18, 19 and 25 contain features that are not supported by the specification (hereinafter the "Features"). Applicant respectfully traverses this rejection at least for the reasons discussed below.

Applicant respectfully submits that the Features are supported by the original specification in such a way as to reasonably convey to one skilled in the art that the inventor was in possession of the claimed invention at the time the application was filed. Specifically, the Features of claims 10, 11, 15, 18, 19 and 25 are clearly shown in the drawings originally filed as part of the specification.

Certain amendments to a specification do not constitute new matter. For example, an amendment is not considered new matter when it simply makes a disclosure of information that one in skilled in the art would have already have understood to be disclosed in the application as originally filed. See generally M.P.E.P. § 2163.07. As another example, rewording and rephrasing of previously disclosed subject matter does not constitute new matter. See, e.g., In re Anderson, 471 F.2d 1237, 1244 (C.C.P.A. 1973).

“[T]o avoid the new matter prohibition, an applicant must show that its original application supports the amended matter.” Schering Corp. v. Amgen, Inc., 222 F.3d 1347, 1352 (Fed. Cir. 2000). “The fundamental inquiry is whether the material added by the amendment was inherently contained in the original application.” Id. Applicant submits that the Features are disclosed by the originally filed drawings.

Applicant respectfully refers Examiner to the case of In re Reynolds, 443 F.2d 384 (C.C.P.A. 1971). In Reynolds, the patent application as originally filed contained a drawing that the Court held taught the features of later-added claims, even though the original specification did not contain text teaching the feature. See generally In re Reynolds, 443 F.2d 384 (C.C.P.A. 1971). In Reynolds, the applicant argued that the drawings disclosed the subject-matter of the later added claims; **the examiner agreed in general with the applicant that the drawing can be used as disclosure in supporting claims** but, contended that the particular drawings in Reynolds’ application did not disclose a certain geometry which was in question and that Reynolds’ position on the issue of presence of the disclosure in question in the drawing was “merely conjecture.” The Court opined on this issue as follows:

First, we do not think [applicant’s] position is ‘mere conjecture’ in view of what is apparently a geometric certainty in Fig. 2. **We realize that a patent drawing does not have to be to any particular scale. Nevertheless, a person attempting to construct a capacitor following appellant’s disclosure would have to distort significantly the relationships shown in Fig. 2 in order not to produce a device which would inherently perform the recited function. In view of the unusual shape of plate 24 and the eccentric mounting of plate 26 on shaft 17, we think a person skilled in the art would suspect that there was some reason for the relationships shown in the drawing and would not regard such disclosure as accidental or arbitrary.**

Id. at 389 (emphasis added) (cited by M.P.E.P. § 2163.07(a) for the additional

proposition that a disclosure of a device in the original application can support a later amendment of a function, use or advantage of that device). A marked-up photocopy of the Reynolds decision is attached for the convenience of the Examiner.

Applicant respectfully submits that the Features cited by Examiner from independent claims 10, 11, 15, 18, 19 and 25 are supported by the originally filed drawings. Generally, the Features relate to the size of the longest side of the base relative to the longest side of the triangular recess. The Features are disclosed at least in Figures 8-11, where it is shown that the base of the inventive cleat fits within the triangular recesses of the prior art. In order for the base of the cleat to fit within the triangular recess in the manner shown by the drawing, it is an inherent geometric necessity that the longest side of the base is shorter than the longest side of the triangular recess.

Regarding dependent claims 12-14, 16, 17 and 20-24, Examiner has not expressly stated which aspect of the claim is the basis of the rejection. Applicant thus believes Examiner has rejected these claims due to the Examiner's concern's regarding the independent claims. Applicant thus respectfully traverses the rejection of dependent claims 12-14, 16, 17 and 20-24 at least for the same reasons as Applicant's traversal of independent claims 10, 11, 15, 18, 19 and 25

For at least these reasons, Applicant respectfully requests that Examiner withdraw the rejection under 35 U.S.C. § 112 ¶ 1 and immediately allow pending claims 10-26.

Rejections under 35 U.S.C. § 112 ¶ 2

At pages 3-4 of the Office Action, Examiner states that claims 1-3, 8 and 10-18 are rejected under 35 U.S.C. § 112 ¶ 2 as failing to particularly point out and identify the

subject matter. Examiner states that there is confusion as to whether Applicant is claiming the cleat or is claiming the cleat in combination with the shoe. The Examiner further indicates that Examiner will treat the claims as if the reference to the shoe is merely a statement of intended use and requested clarification.

For the record, Applicant clarifies that the scope of the claims as follows: Claims 1-3 and 10 through 18 are directed to the cleat. Claims 4 through 9 and 19 through 26 are directed to a shoe having the inventive cleat. Applicant thus respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 112 ¶ 2 and immediately allow claims 1-3, 8 and 10-18.

Rejections under 35 U.S.C. § 132

At page 4 of the Office Action, Examiner states that the amendment of May 30, 2003, is objected to under 35 U.S.C. § 132 as adding new matter with regards to the phrase “has a generally isosceles and/or equilaterally triangular shape recess formed about the receptacle.”

Applicant respectfully traverses this rejection at least for the following reasons.

The text of the May 30, 2003, amendment characterizes the four manufacturer's shoes. The shoes themselves are prior art and this passage is characterizing the prior art. There is a presumption that all those skilled in the art would have all knowledge of the prior art upon reading the patent application and, thus no new matter has been added to the application. For at least these reasons, Applicant respectfully requests that Examiner withdraw the objection under 35 U.S.C. § 132 and allow the amendment.

Rejections under 35 U.S.C. § 102^b(a)

At pages 4-6 of the Office Action, Examiner states that claim 1 is rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 1,055,229 (“Roger”). Applicant has herein amended claim 1 thereby mooting the rejection. Applicant believes that amended claim 1 is patentable and respectfully requests that Examiner allow amended claim 1.

Rejections under 35 U.S.C. § 103(a)

At page 6 of the Office Action, Examiner states that claims 2, 3, and 8 are rejected under 35 U.S.C. § 103(a) as being obvious over Rogers. Applicant amended base claim 1 thereby mooting this rejection. Applicant believes amended claim 1 is patentable and that the dependent claims are thus patentable at least by virtue of their dependency from a patentable claim. For at least this reason, Applicant respectfully requests that Examiner allow dependent claims 2, 3 and 8.

Applicant reserves the right to later argue in this and/or another proceeding that dependent claims 2, 3 and/or 8 are patentable on additional and/or alternative grounds.

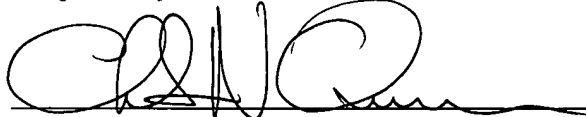
CONCLUSION

Applicant believes that Applicant has fully responded to the Examiner's concerns and that all of the claims are in condition for immediate allowance. Applicant respectfully requests immediate allowance of all claims.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers submitted herewith, please charge all such fees to Deposit Account 50-1943.

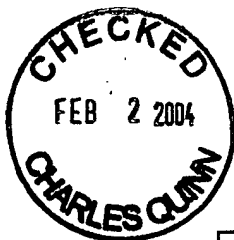
Applicant requests that any questions concerning this matter be directed to the undersigned at (215) 299-2135.

Respectfully submitted,



CHARLES N. QUINN
Registration No. 27,223
Attorney for Assignee
Fox Rothschild, LLP
2000 Market Street, 10th Floor
Philadelphia, PA 19103
Tel: 215-299-2135
Fax: 215-299-2150
email: cquinn@foxrothschild.com

Date: 2 FEBRUARY 2004



**CERTIFICATE OF MAILING
UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Michi Lockner
(signature)

BY: Michi Lockner

DATE: February 2, 2004